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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,374

02/23/2005

Kei Etou

7398/84282

5196

42798

7590

10/01/2008

FITCH, EVEN, TABIN & FLANNERY

P. O. BOX 18415

WASHINGTON, DC 20036

EXAMINER

BURNEY, RACHEL L

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,374	Applicant(s) ETOU ET AL.	
	Examiner Rachel L. Burney	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/28/2008, 06/04/2008, 08/08/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 06/04/2008 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it is a duplicate of the IDS filed 05/28/2008. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

2. The information disclosure statement (IDS) submitted on 05/28/2008 and 08/08/2008 was filed after the mailing date of the application on 02/23/2005. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. US Patent 718676, in the IDS filed on 05/28/2008 was not considered as it is drawn to an overhead traveling crane, filed in 1902.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5639582, Imai et al.

With respect to claims 1 and 7, Imai discloses a toner comprising a core, comprising a silicone-modified resin, and a shell (column 2, lines 4-7), wherein the silicone-modified resin has a softening point of 40-120°C (column 9, lines 28-33), and the shell may be a urea-formaldehyde resin, which is formed by interfacial polymerization over a dispersion of the core particles (column 10, lines 25-61).

The toner is formed by grinding (column 17, lines 30-43).

With respect to claim 2, Imai discloses that the toner has a fusing temperature of 130°C (column 16, lines 1-13).

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5639582, Imai et al. as applied to claim 1 above, and further in view of US Patent 4973541, Kohri et al. Imai discloses the toner of claim 1 as discussed above, wherein the thickness of the shell is brought to a desirable size (column 15, lines 51-55), however Imai fails to disclose what the desired thickness is. Kohri discloses a toner which comprises a core material and a shell material (column 3, lines 7-12), wherein the shell has a thickness of 0.01-0.8 μm in order to provide the proper strength for fixing (column 9, lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a shell thickness of 0.01-0.8 μm for the shell of Imai in order to improve the fixing strength, as taught by Kohri.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5639582, Imai et al. as applied to claim 7 above, and further in view of US PGPub 2002/0055050, Serizawa et al. Imai discloses a method of making the toner which involves a polymerization reaction, but fails to teach aggregation. Serizawa

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discloses a toner which is formed by aggregation, which includes polymerization and agitating the toner particles. It would have been obvious to one of ordinary skill in the art at the time of the invention to use aggregating by polymerization and agitating, as taught by Serizawa, in the polymerizing and agitating step of Anno, and one would have a reasonable expectation of success in doing so.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5639582, Imai et al. as applied to claim 1 above, and further in view of US Patent 6171743, Nakamura. Imai discloses the toner of claim 1 as discussed above, wherein the toner has an average particle diameter of 7 μm (column 17, lines 41-43), but fails to teach the true sphericity of the toner. Nakamura discloses that when the average particle size is between 1 and 10 μm , then the shape coefficient should be 103 to 130 in order to maintain stable chargeability and good imaging properties (column 3, lines 37-53), wherein the shape coefficient is defined in such a way where the closer the value is to 100, the closer the toner particle is to true sphericity (column 3, lines 8-22). The toner of Nakamura may be formed by grinding (column 7, lines 7-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a shape coefficient of 103 to 130 in the toner particles of Imai, resulting in particles which have close to true sphericity, in order to maintain stable chargeability and improve imaging properties, as taught by Nakamura.

Response to Arguments

9. Applicant's arguments, see pages 5 and 6, filed 08/08/2008, with respect to the rejection(s) of claim(s) 1-9 under Anno have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as discussed above.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Burney whose telephone number is (571)272-9802. The examiner can normally be reached on Mon-Thurs: 7:30-6:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark F. Huff/
Supervisory Patent Examiner, Art Unit 1795

RLB